



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/538,752	03/30/2000	Jay S. Walker	99-075	8956
22927	7590	03/14/2006	EXAMINER	
WALKER DIGITAL 2 HIGH RIDGE PARK STAMFORD, CT 06905			RADA, ALEX P	
			ART UNIT	PAPER NUMBER
			3713	

DATE MAILED: 03/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/538,752

Applicant(s)

WALKER ET AL.

Examiner

Alex P. Rada

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-10, 13-16, 18-22, 24, 31-34 and 40-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-10, 13-16, 18-22, 24, 31-34 and 40-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 September 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

In response to the amendment filed September 2, 2005 in which the applicant amends claims 1-2, 19-22, 24, 31-34, adds new claims 40-49, canceled claims 5, 11, 17, 23, 25-30, 35-39, and claims 1-4, 6-10, 13-16, 18-22, 24, 31-34, and 40-49 are pending in this application.

In response to the Non-Responsive amendment filed December 21, 2005 in which the applicant submits arguments to the art rejections and claims 1-4, 6-10, 13-16, 18-22, 24, 31-34, and 40-49 are pending in this application.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: New figure 6, reference numbers 602, 604, 605, 606, 607, 608, 609, 610, and 612. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-4, 6-10, 13-16, 18-22, 24, 31-34, and 40-49 are rejected under 35 U.S.C. 101

because the claimed invention is directed to non-statutory subject matter.

3. Useful, Concrete and Tangible Analysis

For a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result.

In this case, claims 1-4, 6-10, 13-16, 18-22, 24, 31-34, and 40-49 does not provide a tangible result. The claims merely recite determination is made regarding the hand or a plurality of hands of blackjack has resulted in a push, however the result is never functionally used or displayed. The limitation of displaying an indication of the random outcome to the player is just an indication can be broadly interpreted to just be a dealer pointing to the something like cards on the table or to a pair of die. The result of the push is decided, however, the winner is never notified of a result. Applicant's have added the language of, "determining, based on the additional random outcome, which of a plurality of possible winning amounts the player has won if the additional random outcome results in the player winning the hand of blackjack", however, determining, based on the additional random outcome can be broadly interpreted as to be just a decision of a possible win. Again, the winner is never notified after the result nor a tangible result is ever positively recited.

Response to Arguments

4. Applicant's arguments filed December 21, 2005 have been fully considered but they are not persuasive.

Applicants contend that the pending claims do provide a useful, concrete and tangible result. Each of the claims recites generally (i) that a random outcome is received or determined and further (ii) that it is determined, based on the random outcome, if the player has won the hand of blackjack or other card game. These features render the claims statutory for much the same reason the "final share" price of the claims in State Street Bank rendered the claims statutory.

Examiner has read Applicant's argument with respect to State Street Bank with interest. However, Examiner is required to apply the guidelines promulgated by the Office, which was posted on the USPTO web site on October 26, 2005, and published in the Official Gazette on November 22, 2005. According to these guidelines, if the invention does not provide a concrete and tangible result to a person, then the Examiner must reject the claim under 35 USC §101. In determining whether the claim is for a "practical application," the focus is not one whether the steps taken to achieve a particular result are useful, tangible and concrete, but rather that the final result achieved by the claimed invention is "useful, tangible and concrete." If Applicant believes that the Office's policy is in error, the Applicant may, of course, file an appeal. If Applicant wishes to overcome this rejection without the expense and delay associated with filing such an appeal, a simple amendment that will not unduly narrow the scope of Applicant's claims will suffice -- Applicant need only claim that the players are notified of the winner of the game.

Art Unit: 3713

Conclusion

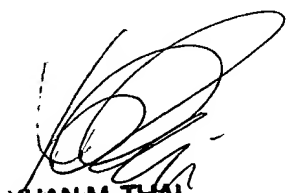
5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alex P. Rada whose telephone number is 571-272-4452. The examiner can normally be reached on Monday - Friday, 08:00-16:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


APR


XUAN M. THAI
SUPERVISORY PATENT EXAMINER
TC3700